

PATENT  
Docket No.: AT000040  
Customer No. 000024737

### REMARKS

By this amendment, claims 1-8 have been amended. New claim 9 has been added. Claims 1-9 remain in the application. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, and allowance of the application, as amended, is respectfully requested.

#### Specification

The abstract was objected to for reasons stated in the office action. By this amendment, the abstract has been amended to not exceed 150 words in length and to be a single paragraph. In addition, the abstract contains no reference to the drawings. Furthermore, the words "Fig. 1" have been removed from the end of the abstract. Accordingly, objection to the abstract is believed overcome. Withdrawal of the objection is respectfully requested.

The title was objected to as not being descriptive. (The title suggested in the office action is the same as the original title.) By this amendment, the title has been amended to be more indicative of the invention to which the claims are directed. Withdrawal of the objection to the title is respectfully requested.

The specification was objected to in that trademarks are noted in the application. By this amendment, the specification has been amended to capitalize the noted trademarks wherever they appear. Accordingly, withdrawal of the objection to the specification is respectfully requested.

#### Claim Objections

Claims 1-8 were objected to because of various informalities. By this amendment, the claims have been amended to appropriately correct for the informalities identified in the office action. Accordingly, objection to the claims is

PATENT  
Docket No.: AT000040  
Customer No. 000024737

believed overcome. Withdrawal of the objection to the claim is respectfully requested.

**Rejection under 35 U.S.C. § 103**

**Claim 1**

Claim 1 recites a recording apparatus for recording speech information of a dictation and for subsequent transfer of the recorded speech information to a speech recognition device for off-line speech recognition, said apparatus comprising: receiving means for receiving the speech information of the dictation; recording means for recording the received speech information of the dictation in a recording mode of the recording apparatus; transfer means for transferring recorded speech information of the dictation to the speech recognition device in a transfer mode of the recording apparatus, which speech recognition device is arranged for recognizing text information to be assigned to the transferred speech information, the quality of the recognized text information depending on the quality of the received speech information; speech quality test means for testing whether a quality of the speech information received in the recording mode is sufficient for obtaining a predefined quality of the recognized text information in response to the speech recognition device processing the speech information transferred by the transfer means in the transfer mode, wherein the speech quality test means tests at least one selected from the group consisting of a signal-to-noise ratio of the received speech signal, a level of the received speech signal, and a velocity of speech in the received speech signal, and wherein the speech quality test means outputs a quality information signal as a function of testing the corresponding signal-to-noise ratio of the received speech signal, the level of the received speech signal, and the velocity of speech in the received speech signal; and feedback means responsive to the quality information signal in the recording mode for transferring feedback information in the recording mode, wherein the feedback information represents at least one of a corrective measure and a result of the corresponding quality test of the speech quality test means.

PATENT  
Docket No.: AT000040  
Customer No. 000024737

Claims 1 and 5-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Comerford et al (U.S. Patent No. 5,243,149 A), in view of Brooks et al (U.S. Patent No. 6,477,493 B1).

Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to claim 1.

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for at least the following, mutually exclusive, reasons.

**1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The Comerford et al and Brooks et al patents cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ...*  
(Emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither Comerford et al nor Brooks et al teaches a specific speech quality test means for testing ..., wherein the speech quality test means tests a signal-to-noise ratio of the received speech signal, a level of the received speech signal, and a velocity of speech in the received speech signal; and

PATENT  
Docket No.: AT000040  
Customer No. 000024737

wherein the speech quality test means outputs a quality information signal as a function of testing the corresponding signal-to-noise ratio of the received speech signal, the level of the received speech signal, and the velocity of speech in the received speech signal; and feedback means responsive to the quality information signal in the recording mode for transferring feedback information in the recording mode, wherein the feedback information represents at least one of a corrective measure and a result of the corresponding quality test of the speech quality test means as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met. In contrast, Comerford *et al* discloses a notepad for capturing digitized stylus information and audio annotation to accompany the digitized stylus information. Brooks *et al* discloses a computer recognition system designed to enroll a user using an enrollment script to train a speech recognition system.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**2. The recognition of a problem, or of the source of the problem, is not obvious even though the solution to the problem may be obvious**

In the present case, it is apparent from a reading of the Comerford *et al* patent and the Brooks *et al* patent that neither recognized the problem of an off-line speech recognition device arranged for recognizing text information to be assigned to speech information received by a receiving device and that a quality of the off-line recognized text information depends on the quality of the received speech information as the speech information is being received, that is, whether a signal-to-noise ratio of the received speech information is below a threshold level, whether a level of the received speech information signal is below a threshold level, and whether a speech velocity of the received speech information is above a threshold level. In contrast, while Comerford *et al* discloses correlating speech and text, such a correlation is in the context of linking occurrences of speech annotation with separate occurrences of scribed gestures of text

Page 13 of 16

PATENT  
Docket No.: AT000040  
Customer No. 000024737

to recreate an annotated document. Thus, this is a classic example of a solution to a problem being obvious only after recognition of the problem by the applicant and is part of the "subject matter as a whole" language of 35 USC § 103 which should always be considered in determining the obviousness of an invention under this statute.

Thus, for this independent reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

### 3. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the Comerford *et al* and Brooks *et al* patents cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

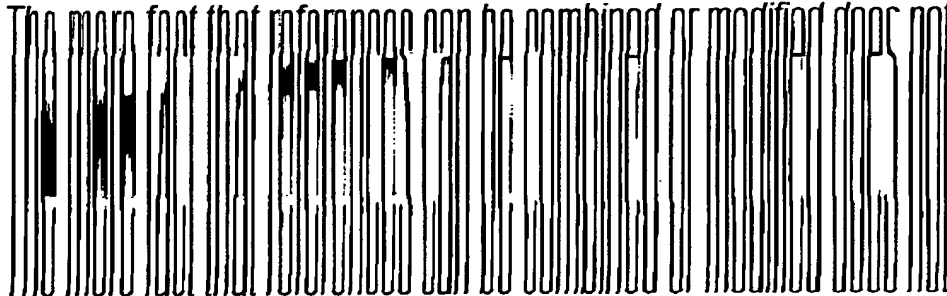
Here, neither Comerford *et al* nor Brooks *et al* teaches, or even suggests, the desirability of the combination since neither teaches the specific speech quality test means that tests a signal-to-noise ratio of the received speech signal, a level of the received speech signal, and a velocity of speech in the received speech signal; and wherein the speech quality test means outputs a quality information signal as a function of testing the corresponding signal-to-noise ratio of the received speech signal, the level of the received speech signal, and the velocity of speech in the received speech signal, as specified above and as claimed in claim 1.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

Page 14 of 16

PATENT  
Docket No.: AT000040  
Customer No. 000024737

In this context, the MPEP further provides at § 2143.01:



*render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Accordingly, claim 1 is allowable and an early formal notice thereof is requested.

Dependent claims 5-7 depend from and further limit independent claim 1 and therefore is allowable as well.

Claims 2-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Comerford *et al* in view of Brooks *et al*, and further in view of Polikaitis *et al* (EPO Patent GB 2,346,001A). Applicant respectfully traverses this rejection for at least the following reasons. Claims 2-4 depend from allowable base claim 1. That is, dependent claims 2-4 depend from and further limit independent claim 1 and therefore are allowable as well.

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Comerford *et al* in view of Brooks *et al*, and further in view of Kopp *et al* (U.S. Patent 5,809,464 A). Applicant respectfully traverses this rejection for at least the following reasons. Claim 8 depends from allowable base claim 1. That is, dependent claim 8 depends from and further limits independent claim 1 and therefore is allowable as well.

PATENT

Docket No.: AT000040  
Customer No. 000024737

Conclusion

It is clear from all of the foregoing that independent claim 1 is in condition for allowance. Dependent claims 2-8 depend from and further limit independent claim 1 and therefore are allowable as well. New claim 9 is similar to claim 1 and is believed allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced.

An early formal notice of allowance of claims 1 -9 is requested.

Respectfully submitted,

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